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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,166	06/28/2003	Rajendra Kashinath Singh	GEPL.P-072	1165

43247 7590 04/24/2006

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EXAMINER	
YOON, TAE H	

ART UNIT	PAPER NUMBER
1714	

DATE MAILED: 04/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/604,166	**Applicant(s)** SINGH ET AL.	
	Examiner Tae H. Yoon	**Art Unit** 1714	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 April 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: 1-25.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

Tae H Yoon
Primary Examiner
Art Unit: 1714

Continuation of 5. Applicant's reply has overcome the following rejection(s): Double patenting rejection, anticiaption rejection based on Rosenquist et al and 112, 1st rejection.

ATTACHMENT TO ADVISORY ACTION

Double patenting rejection and anticipation rejection under 102(b) based on Rosenquist et al are withdrawn. Note that the body of rejection for said anticipation rejection under 102(b) and 103(a) based on Rtosenquist et al recites obviousness and thus said 102(b) was an error. Obviousness rejections based on Rosenquist et al and Mark et al as primary references are maintained.

Applicant asserts the Patent Office error regarding tables and improper final rejection, but the examiner disagrees with such assertion since the presence of said tables in the specification before the first office action or not would not change the sequence of the communication and results: 1. The examiner sends out the first office action, 2. Applicant asserts unexpected results with respect to said first office action, 3. The examiner addresses differences between the scope of claims and data, and sends out the Final office action, and 4. Applicant responds.

With respect to 103(a) rejection of Rosenquist et al, Sakashita et al and Mestanza, first, the instant claims are directed to a polycarbonate composition, and thus the recited polymerization process for a polycarbonate has little probative value. An invention in a product-by-process is a product, not a process. See ***In re Brown***, 459 F2d 531, 173 USPQ 685 (CCPA 1972) and ***In re Thorpe***, 777 F2d 695, 697, 227 USPQ 964 (Fed. Cir. 1985). Second, even if such process were to have any probative value, Rosenquist et al teach that the method of making a polycarbonate is well known in the art and cite Sakashita et al (US 5,606,007) at col. 2, line 14, and thus the use of such

polycarbonate of Sakashita et al is a *prima facie* obviousness. Mestanza also teaches the use of an acid quencher. Again, applicant asserts that the examiner has failed to provide quencher ratio in the first office action, but the examiner disagrees with such assertion since the examiner has clearly pointed out the example 1 of Sakashita et al in the first action. Any one of ordinary skill in the art reading said example 1 would know a molar ratio of 5 without any further elaboration.

Applicant asserts that Batches 3 and 4 would not be the invention, and thus tables 1 and 2 present unexpected results. But, as pointed out in the previous office action, the scope of the instant claims is broader than the showing. Batches 3-8 of table 1 and Batches 1 and 2 of table 2 would meet the invention according to applicant's response. However, said Batch 3 shows a molar ratio of 2.4, but does not show the claimed lowest molar ratio of 1. Said Batch 8 shows a molar ratio of 24.2, but does not show the claimed highest molar ratio of 30. Applicant asserts a molar ratio of 1 to 15 for claims 7,9,13,15,21 and 23, but again examples neither show the lowest molar ratio of 1 or the highest molar ratio of 15 (only molar ratio of 12.1 is shown). Showing of at least the ending points (a molar ratio of 1, 2, 15, 24, 25 and 30) is needed, but applicant failed to show such. The molar ratio of the claim 25 is basically shown in table 1, but the recited acidic quencher and basic catalyst is broader than showing of butyl tosylate and sodium hydroxide.

Applicant asserts that a showing of every possible embodiment is not needed, and the examiner agrees with applicant's assertion. In fact, no example or showing is

required, but the office action containing a *prima facie* obviousness raises issues which applicant could overcome. But, applicant failed to do so.

Applicant assert that sodium salt is a typical basic catalyst and that said basic catalysts are generally considered as interchangeable. However, such general characterization does not have probative value, and an amine compound would be a basic catalyst and it is uncertain whether said amine compound would act in the same manner as said sodium salt. Claim 2 reciting a sodium salt does not address a particular acidic quencher, and thus the scope of the claims is broader than the actual invention.

Applicant failed to address the obviousness rejection based on Mark et al (US 4,130,530) and secondary references.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tae H Yoon
Primary Examiner
Art Unit 1714

THY/April 17, 2006